PATENT APPLICATION
Attorney Docket No. **10351-004**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: John A. Kembel et al.	)	Art Unit: 2176
	)	
Appl. No.: 09/558,922	)	Confirmation no.: 1665
	)	
Filed: 04/26/2000	)	Examiner: C. T. Nguyen

Title: Apparatus and Method of Hosting Internet Content

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Assistant Commissioner for Patents
Washington, D.C. 20231

REVISED APPEAL BRIEF

Sir:

This Revised Appeal Brief is submitted in response to the Notification of Non-Compliant Appeal Brief, mailed August 23, 2007 (the "Notification"). The only revisions made herein are to the heading of section VI, which has been amended, and the removal of section VII, each as requested in the Notification. Applicant respectfully submits this Appeal Brief in the appeal from the Office Action dated March 6, 2007, (hereinafter referred to as the "Final Office Action") in which all claims were finally rejected. Applicant's Notice of Appeal was filed on June 4, 2007.

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1. Real Party of Interest

The real party in interest is Mainstream Scientific, LLC, the assignee of all right and interest in and to the present application and any patent issuing thereon.

2. Related Appeals and Interferences

The subject matter of this appeal relates to the subject matter of:

(1) Application 09/558,925, titled "Apparatus and Method for Interacting with Internet Content", assigned to the same assignee as the present case, which case stands finally rejected and for which an appeal brief was filed on March 5, 2007; and

(2) Application 09/558,923, titled "Apparatus and Method for Dynamically Coordinating the Delivery of Computer Readable Media", assigned to the same assignee as the present case, which case stands finally rejected and for which an appeal brief was originally filed on May 4, 2007, and refiled on July 10, 2007.

3. Status of the Claims

Claims 32 and 35-43 are pending in the present application. Claims 1-31, 33-34, and 44-57 were previously cancelled. Claims 32 and 35-43 were finally rejected in the Final Office Action and currently stand finally rejected. Claims 32 and 35-43 are appealed.

4. Status of Amendments

No amendments after the Final Office Action have been submitted. All prior amendments have been entered.

5. Summary of Invention

The present invention is directed to a method for providing certain Internet (or web) content and functionality to a user together with a user interface in which the content is viewed at the user's workstation. Importantly, while the content is of a form which may be viewed by a web browser application, instead according to the present invention the content is caused to be displayed in the user interface outside of and independent from a web browser application.

The nature of the user interface (its look and feel, its size, its location, its controls, its functionality, etc.) is specified to the user by way of a definition, and may be a function of the type of content being provided. The definition also includes a software component which operates on the content. The customized user interface in which the content is displayed, together with the controls and other functionality associated with that interface, are referred to as a networked information monitor or NIM, in the specification. The user interface operating on a user's computing device is operated in conjunction with a manager for such interfaces, which is itself a program (or process) executing on the user's computing device. No web browser program or instance of a web browser program is required to render the content or interact with the user interface. The manager program can provide certain functionality to the user interface, such as code parsing, control functionality, etc., so that each user interface need only focus on and contain code for the unique attributes of that interface.

As a simplified example, the user interface may appear as a dedicated frame on a computer desktop in the image of a small map for indicting the current regional weather, the definition being computer programming code for rendering the map (interface), obtaining the weather data (content), and proving controls therefor on the user's desktop. The functionality may be programming code which operates to obtain the current regional weather, for example, from a designated website, as well as cause the display of that data in a selected format at a desired location on the rendered map.

In general, the nature of the user interface can be a function of the content to be displayed, as in the aforementioned map to show the location of a weather forecast. Thus, content providers (who are generally unassociated with the provider of the system for managing the various user interfaces) may be provided with the tools and ability to define a user interface which best suits the content they seek to present. Accordingly, the nature of the user interfaces may vary from content to content. Optionally, there may be common attributes to the various user interfaces provided by content providers, as might be determined by a distributor of the content-functionality-interface packages (and provided by the user interface manager program). But such commonality does not hide the uniqueness of the user interfaces specific to the content they are designed to display.

In other words, the present invention is directed to methods which are operable on a user's computer, which utilize content in a web-based computer format, and which display that content outside of a web browser application, to thereby allow a content

provider to side-step the constraints on presentation of the content imposed by traditional web browser user interfaces. The methods themselves are applications also designed to run separate and apart from a web browser application. The methods render user interfaces which include functionality and appearance appropriate for specific content, without being constrained to display the content within the frame of a web browser user interface.

Therefore, one of the key ideas underlying the appealed claims is to provide a browser-independent display window specifically designed to display web content outside of a window of a conventional web browser. By simply identifying and requesting the browser-independent display window, operational elements required to render and populate that window are assembled and transmitted to the computing device.

Thus, the independent claims of the present application are essentially directed to a method for providing specific information to a user. That information includes:

(1) content in a format readable by a Web browser program outside of a window of a Web browser program (claim 32, lines 4-5; see also claim 39, lines 4-7),

(2) instructions for invoking a computing device resident process (claim 32, lines 5-6; see also claim 39, lines 5-6),

(3) the instructions executable independent of a Web browser (claim 32, line 6), and

(4) a definition that defines at least in part a functionality and an appearance of a user interface (claim 32, lines 6-7; see also claim 39, lines 8-10).

The dependent claims provide additional functional limitations, such as defining the frame in which the content is rendered (claim 35, claim 40), defining a frame and functionality of that frame in which the content is rendered (claim 36, claim 41), enabling a web content provider to define the frame and functionality (claim 37, claim 42) as well as a device resident process (claim 38, claim 43).

6. Grounds of Rejection to Be Reviewed on Appeal

All claims of the present application were rejected under 35 U.S.C. 103(a) over Dasan (US Patent 5,761,662) in view of Furst (US Patent 6,297,819). Thus, there is a single overarching issue to be reviewed on appeal:

> Are claims 32 and 35-43 unpatentable under 35 U.S.C. 103(a) over Dasan (US Patent 5,761,662) in view of Furst (US Patent 6,297,819)?

7. (Section deleted)

8. Argument

A. Independent claims 32 and 39

Applicant argues below that neither Dasan nor Furst, nor the combination of Dasan with Furst, teach or suggest a method for providing information to a user which includes:

(1) data, in a format readable by a Web browser program, for presentation outside of a window of a Web browser program (e.g., claim 32, lines 4-5 and claim 39, lines 4-7);

(2) instructions for invoking a computing device resident process (e.g., claim 32, lines 5-6 and claim 39, lines 5-6);

(3) said instructions being executable independent of a Web browser (e.g., claim 32, line 6); and

(4) a definition of functionality and appearance of a frame outside of a window of a web browser within which the results of the computing device resident process are presented (claim 39, lines 8-10).

While applicant discusses each of these points individually below, it is the combination of these elements in the claims which form the distinction between those claims and the cited references, and hence the basis for this appeal.

(1) Data, in a format readable by a Web browser program, for presentation outside of a window of a Web browser program

Neither reference discloses or suggests the provision of web content for display outside of a window of a web browser program. In applicant's response dated December 30, 2005, it was established that Dasan teaches that a user establishes a profile, which is a list of topics of interest, and a list of web sites at which to look for the topics of interest. The system examines those sites for items containing the identified topics of interest, then presents those items for display in the user's browser window. Therefore, Dasan fails to teach delivery of content for display outside of a window of a web browser program.

Furst illustrates icons which "span" the scroll bar of a browser window (Furst, vol. 8, lines 43-46, Fig. 5). These icons are, therefore, partially within (and form a part of) the browser window - not "outside" the window of the web browser program. (Assuming a common definition for "outside" such as "on the outer side of; external to; beyond the limit of; not within…", found at Oxford English Dictionary, Oxford University Press, 2002.)

In response to applicant's argument that Furst illustrates icons which "span" the scroll bar of a browser window, the Final Office Action cites col. 4, line 57 to col. 5, line 11, as showing display of web content "outside" of the window of a web browser program. However, applicant respectfully disagrees that this is what the cited section of Furst teaches.

The gist of the Furst reference is a system allowing services, such as program applications (referred to as tools), located on a computer other than a user's computer to run on the user's computer. This is accomplished by running a system program (called a client) on the user's computer which "interacts with the user's running web browser" (Furst, col. 2, lines 16-17) and servers on which the tools are located. In the language of Furst, this is explained as a system providing "World Wide Web browser extensions based on server processes rather than on plug-in program modules loaded and installed on a user's machine." (Furst, abstract, lines 3-5.) A user's interface to the tools are by way of windows of the type shown at 402 and 404 in Fig. 4A, or alternatively as other objects such as icons 502, 504, 506 shown in Fig. 5 "displayed by a web browser operating as a program embedded in the client." (Furst, col. 2, lines 29-30, emphasis added).

One key aspect of Furst is that it is "a browser-aware application delivery system." (Furst, col. 1, lines, 56-57.) That is, it is designed to augment the use of a browser application in surfing the web. The client (the system taught by Furst) is referred to as a "thin shell" (a shell being a program interface, see, e.g., www.webopedia.com/TERM/s/shell.html) in which a browser program is running. (Furst, col. 4, lines 63-65.) Remote tools may be accessed by the client through windows of the browser program. That is, the browser provides both access to the application programs and the interface for those programs. These interfaces are windows of a web browser program. Therefore, web pages displayed by the client are displayed within a window of a web browser.

The examiner specifically points to col. 2, line 55 to col. 3, line 6, for the argument that a user may "find at every web site additional functionality that is independent of the web sites" (Final Office Action, page 6, lines 19-20). Applicant argues that this statement simply means that for appropriate web sites a user visits, the client may provide access, via a web browser window, to supplemental tools not provided by the original site the user is visiting. It does not alter in any way the fact that the windows Furst generates are windows of a browser application (albeit an embedded browser).

Since neither reference teaches or suggests data displayed "outside of a window of a Web browser program", the combination of the two references cannot teach or suggest that feature. For this reason alone, the claims of the present application are patentably distinct form Dasan and Furst, when considered alone or in combination.

(2) Wherein the information includes instructions for invoking a computing device resident process

As to point (2), as argued in applicant's response dated November 28, 2006, Dasan performs all functions as server-resident processes (e.g., col. 4, lines 42-44), as opposed to computing-device resident processes. Likewise, according to Furst, all applications operate at remote servers ("a client program...interacts with the ...core servers" col. 2, lines 14-17, and "All data is stored on database servers. Only HTML

cookies are placed on the user's computer." Col. 5, lines 33-35.) Through their stated dependence on servers, Dasan and Furst negate the need for obtaining instructions for executing operations on the user's computer. In effect, they teach away from obtaining such instructions as their focus is on remotely operating applications. In any event, neither Dasan nor Furst teach obtaining information which "includes instructions for invoking a computing device resident process" (the computing device being the user's computing device per claim 32, line 3). Therefore, the two references, alone or in combination, cannot teach or suggest that feature.

In response to this argument, the Final Office Action states that Dasan discloses at Fig. 10 that the user selects or clicks on any icons 1002-1010 for topic selections, and then the user clicks on generate icon 1018, and the newspaper is generated based upon the topic selections (Dasan, col. 7, lines 42-60). While applicant agrees that that is what Dasan says, applicant does argue that each of the steps of this process takes place on a server remote from the user's computer. In support of this assertion, attention is directed to Dasan, col. 8, lines 22-26, at which is it stated:

> Fig. 11 shows the results of the creation of a personal newspaper – the personal newspaper main screen. This is displayed at the client as a result of the full-text searching, the parsing and HTML page generation process performed at the server as discussed above. (Emphasis added.)

Clearly this section states that the process of newspaper generation takes place on the server (and the statement "as discussed above" means this description modifies the preceding section – the very section cited in the Final Office Action.)

Therefore, for a second reason, the claims of the present application are patentably distinct form Dasan and Furst, when considered alone or in combination.

(3) Executable independent of a Web browser

As to point (3), in a prior Office Action it was conceded that Dasan does not teach or suggest that the computing device resident process is executable independent of a Web browser. In the Final Office Action, reliance is placed on Furst (col. 4, line 57 to col. 5, line 11) to show process execution independent of a web browser. Applicant disagrees.

According to Furst, a program is downloaded and installed on the user's computer (col. 4, lines 42-46). However, this software is coupled to the user's web browser application visually (e.g., Fig. 5) and logically (col. 5, lines 12-20). Among the many statements demonstrating the dependence upon a web browser, Furst states that "[t]he core functionality is provided by one or more servers...and a client program running on the user's computer that interacts with the user's running web browser..." (col. 2, lines 13-17, emphasis added) and furthermore that "[t]he client 124 is essentially a thin shell for an embedded web browser, whose function is to display web pages sent

by the System or by component application tools" (col. 4, lines 63-65, emphasis added). Furthermore, the "client" as defined by Furst has a web browser program embedded therein (col. 4, lines 63-65), and hence is not by any sense of the word "independent" from a web browser program.

In fact, as Furst is replete with references to and illustrations of the dependence on a web browser, to render tool windows without a web browser application becomes a significant modification to the fundamental operating principles of the invention disclosed by Furst. As a matter of law, if such a significant modification is required to yield the claimed invention, then a finding of obviousness cannot be sustained. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." M.P.E.P. § 2143.01(VI).

Accordingly, neither Dasan nor Furst teach or suggest a process executable independent of a Web browser application. Therefore, the combination of those references likewise fails to provide such teaching. Thus, for a third reason, Dasan and Furst, alone or in combination with one another fail to teach or suggest the limitations of claims 32 or 39.

(4) The information including a definition of functionality and appearance of a frame outside of a window of a web browser within which the results of the computing device resident process are presented

Applicant argues that there is a fundamental difference between the limitations of the appealed claims and the cited references relating to ***where*** windows are rendered. Claim 39 of the present application recites in part "a definition of functionality and appearance of a frame outside of a window of a web browser within which the results of the computing device resident process are presented" (claim 39, lines 8-10). (That is, applicant focuses here on ***where*** the visual manifestation of the first internet content is rendered.)

It has previously been concluded that Dasan does not teach rendering windows outside a window of a web browser program. A careful reading of the Furst reference shows that it also does not disclose a user interface outside of the window of a web browser. Again, the tool windows of Furst are rendered by an embedded browser application. Therefore, those windows are rendered by a web browser application (associated with other software). Applicant finds nothing disclosed in Furst teaching the rendering of a tool window such that it is not itself a window of a browser program.

Furthermore, while Fig. 5 shows tool icons rendered as "tabs" connected to and extending without and within a web browser window, this rendering of the tabs connected to and partially within the browser window is quite the opposite of rendering the tool such that it is "outside of a window of a Web browser program". Applicant finds

no text in Furst relating to Fig. 5 which states or suggests that the tabs might be rendered fully separated from or outside of (i.e., not confined by) the frame of the web browser window. To the contrary, it is stated that the tools are shown to "span the scroll bar of the current web browser window" (column 8, lines 45-46). Therefore, applicant asserts that Furst is silent about actually rendering tools such that they are outside of a window of a web browser program.

Accordingly, neither Dasan nor Furst teach information including a definition of functionality and appearance of a frame outside of a window of a web browser within which the results of the computing device resident process are presented. Therefore, the combination of those references likewise fails to provide such teaching. Thus, for a fourth reason, Dasan and Furst, alone or in combination with one another fail to teach or suggest the limitations of claim 39.

(5) No prima facie case of obviousness has been made

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Applicant has demonstrated above that a significant number of limitations are not found in the cited references, including:

(1) assembling data which is in a format readable by a Web browser program outside of a window of a Web browser program;

(2) instructions, included with the information, for invoking a computing device resident process;

(3) said instructions being executable independent of a Web browser; and

(4) the information including a definition of functionality and appearance of a frame outside of a window of a web browser within which the results of the computing device resident process are presented.

Therefore, no *prima facie* case of obviousness has been established with regard to claims 32 and 39. Therefore, on these grounds, applicant respectfully appeals the rejection of independent claims 32 and 39. In light of the arguments presented above, applicant respectfully requests further consideration of these claims and an indication of their allowability over the cited references and comments in the Final Office Action.

B. Dependent claims

As will be appreciated, by their dependence on claim 32, each of claims 35-38 are patentably distinct from Dasan and Furst for at least each of the reasons discussed above with regard to claim 32. Likewise, by their dependence on claim 39, each of claims 40-43 are patentably distinct from Dasan and Furst for at least the reasons discussed above with regard to claim 39. However, each of claims 35-38 and 40-43 introduce additional limitations which, in combination with the above, are not found in the cited references. For instance:

1) Claims 35 and 40 introduce the limitation that at least a portion of the user interface is a frame within which the results of the computing device resident process are presented. One key feature of the present invention is that a content provider can define the frame in which the content is to be displayed, and bundle together for delivery both the content and the frame definition. According to Dasan, items in which a user indicates an interest (1104, 1106, 1008) are listed within a rectangular frame (see col. 8, lines 23 –34). There is nothing stated in the reference about data within the information retrieved which specifies in any way the characteristics of the frame or window format in which that particular data is displayed. Likewise, Furst is silent as to where frame definitions are obtained, how they are modified, etc., and specifically is silent as to any teaching or suggestion that any data obtained from a website include information defining a frame for the display of such data.

2) Claims 36 and 41 recite that a portion of the definition fully describes a functionality and appearance of a frame within which the results of the computing device resident process are presented. That is, the appearance and the functionality of the frame are completely and solely defined in the retrieved information. Per the above, neither Dasan nor Furst specify or suggest that the information they retrieve defines appearance and functionality of a frame, let alone fully do so.

3) Claims 37 and 42 recite that the definition is provided by a web content provider. This feature highlights the ability for the content provider to control both the content and the functionality/appearance of the interface in which the content is rendered. Again, the cited references are silent as to the source of the definition of the frames rendered by each.

4) Claims 38 and 43 recite that the computing device resident process is also provided by the web content provider. This feature further highlights an aspect of the claimed invention according to which a content provider can provide a complete package of content, a computing device resident process, content to be operated on by said computing device resident process, and a frame and functionality for displaying the results of the process. Such control and the elements providing it are neither contemplated nor disclosed by the Dasan or Furst, taken alone or in combination.

Since additional critical limitations of claims 35-38 and 40-43 are not found in the cited references, no *prima facie* case of obviousness has been made. In re Royka, supra. Therefore, on these grounds, applicant respectfully appeals the rejection of claims 35-38 and 40-43. In light of the arguments presented in this section as to dependent claims 35-38 and 40-43, as well as the preceding section of this Appeal Brief discussing independent claims 32 and 39, applicant respectfully requests further consideration of these claims and an indication of their allowability over the cited references and comments in the Final Office Action.

9. Summary and Conclusion

In summary, the applied references, alone or taken in the proposed combination, fail to teach or suggest each and every one of the limitations found in each of claims 32 and 35-43. Accordingly, no *prima facie* case of obviousness has been made as to any of the pending claims of the present application. Accordingly, applicant requests that the Board reverse the final rejection of all claims, with remand to pass this application to allowance.

Respectfully submitted,

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APPENDIX 1 – Appealed Claims

32. A method of providing content to a user, comprising:

receiving a request for the content;

in response to the request, retrieving information usable by a computing device to present data that is programmed in a format readable by a Web browser program outside of a window of a Web browser program, wherein the information includes instructions for invoking a computing device resident process executable independent of a Web browser and a definition that defines at least in part a functionality and an appearance of a user interface outside of a window of a Web browser program and within which the results of the computing device resident process are presented; and

transmitting the information.

35. The method of claim 32, wherein at least a portion of the user interface is a frame within which the results of the computing device resident process are presented.

36. The method of claim 32, wherein at least a portion of the definition fully describes a functionality and an appearance of a frame within which the results of the computing device resident process are presented.

37. The method of claim 36, wherein the definition is provided by a Web content provider, thereby enabling the Web content provider to control at least in part a functionality and an appearance of the frame when rendered.

38. The method of claim 37, wherein the computing device resident process is provided by the Web content provider.

39. A method of providing Internet content to a user of a computing device, comprising:

receiving a request from a computing device;

in response to the request, retrieving data that is programmed in a format readable by a Web browser program, the data comprising instructions for invoking a computing device resident process and content data to be displayed at the computing device outside of a window of a Web browser program in response to execution of said computing device resident process, and a definition that defines at least in part a functionality and an appearance of a user interface outside of a window of a Web browser program and within which the results of the computing device resident process are presented, and

transmitting the data to the computing device.

40. The method of claim 39, wherein at least a portion of the user interface is a frame within which the results of the computing device resident process are presented.

41. The method of claim 39, wherein at least a portion of the definition fully describes a functionality and an appearance of a frame within which the results of the computing device resident process are presented.

42. The method of claim 39, wherein the definition is provided by a Web content provider, thereby enabling the Web content provider to control at least in part a functionality and an appearance of the user interface when rendered on the computing device.

43. The method of claim 42, wherein the computing device resident process, content data, and the definition are provided by the Web content provider, thereby enabling the user interface to integrate seamlessly with the results of the computing device resident process and content data.

APPENDIX 2 – Evidence of Record

No additional evidence is being submitted with this appeal.

APPENDIX 3 – Related Proceedings

There are currently no proceedings related to this appeal.